

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claim 1 has been amended. Thus, claims 1-13 and 15-25 are currently pending in the application and subject to examination.

In the Office Action mailed August 15, 2006, the Examiner rejected claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,428,529 to Hartrick et al. ("Hartrick") in view of U.S. Patent No. 5,509,074 to Choudhury ("Choudhury"); claims 13 and 17-19 as being unpatentable over U.S. Patent No. 6,243,071 to Shwartz et al. ("Shwartz") in view of U.S. Patent No. 5,089,956 to MacPhail ("MacPhail"); claims 21-25 as being unpatentable over U.S. Patent No. 5,739,814 to Ohara et al. ("Ohara") in view of Choudhury; claim 12 as being unpatentable over Hartrick in view of Choudhury and further in view of U.S. Patent No. 4,985,697 to Boulton ("Boulton"); claim 15 as being unpatentable over Shwartz in view of MacPhail in further view of Boulton; claim 16 as being unpatentable over Shwartz in view of MacPhail and further in view of U.S. Patent No. 4,644,470 to Feigenbaum ("Feigenbaum"); and claim 20 as being unpatentable over Shwartz in view of MacPhail and further in view of Choudhury. It is noted that claim 1 has been amended. To the extent that the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejections as follows.

I. Claims 1-11

Applicant's invention as set forth in claim 1 is directed to a method of communicating between components of a home subsystem comprising a home library

for receiving and storing electronic books, the electronic books comprising data text and a unique key associated therewith, and a portable, electronic viewer for processing and displaying the electronic books, said portable viewer having a unique key associated therewith, the method comprising: in the library, without user input comparing the unique key associated with data text of an electronic book to the unique key identifying the electronic viewer, if the comparing step produces a match, sending the data text related to an electronic book from the library to the viewer, and storing the data text in the viewer.

By using electronic books that include both text and a unique key associated therewith, the electronic books will only be sent to authorized electronic viewers without relying on the input of an identification number by the user. The library automatically compares the keys and only sends the electronic book to be stored in the electronic viewer if the unique key associated with the book matches the unique key associated with the electronic viewer.

Hartrick teaches electronic documents including a password and before “any further display or printing”, requires the user to enter a password. (See column 4, lines 36-39). Similarly, Choudhury teaches requiring a user to enter a unique identification number in order to view or print a document. (See column 3, lines 51-53 and column 4, lines 26-31).

Hartrick does not disclose or suggest a portable, electronic viewer having a unique key associated therewith and in the library, without user input, comparing a unique key associated with data text of the electronic book to the unique key identifying the portable, electronic viewer, as indicated in the Office Action.

Instead of without user input comparing a unique key associated with data text of the electronic book to the unique key identifying the hardware to which the text will be sent, or the portable, electronic viewer, Hartrick teaches requiring the entry of a password from a user and comparing the key of the text to the entered password.

Furthermore, Choudhury does not disclose or suggest the feature of when a comparing step produces a match, sending the text data to the viewer, as indicated in the Office Action. Instead, Choudhury merely teaches requiring entry of a password from a user before viewing or printing a document, similar to Hartrik. Hartrik and Choudhury both describe allowing viewing and printing of a document after the entry of a password from a user. However, neither of them describes sending text data and storage of a text data in a viewer after comparing the unique key associated with data text of an electronic book to the unique key identifying the electronic viewer produces a match.

For at least this combination of reasons, the Applicant submits that claim 1 is allowable over the cited art. As claim 1 is allowable, the Applicant submits that claims 2-12, which depend from allowable claim 1, as also allowable for at least the above described reasons and for the additional subject matter recited therein.

II. Claims 13, 15-20

Applicant's invention as set forth in claim 13 is directed to a method for processing text data for an electronic book in an electronic book home system comprising a library and viewer, the method including: communicating the purchase of an electronic book; attaching a unique packet identifier that matches a library identifier associated with the purchaser's library to a packet of text data; after the unique packet

identifier is attached, receiving the packet of text at the library, if the packet has a unique identifier, determining whether the packet identifier matches the library identifier of the library; and if the packet identifier matches the library identifier, storing the packet to a data file in a library storage.

Shwartz teaches a method for controlling a screen display of an electronic book, wherein book packages are installed if the electronic book is valid. Shwartz defines valid electronic books as having a title slot and an ISBN slot. (See Shwartz, column 12, column 13, and figures 5 and 6).

Shwartz does not disclose or suggest communicating the purchase of an electronic book. In figure 5, element 122, Shwartz merely teaches communicating the arrival of a book package.

The Office Action indicates that the library ID is equivalent to the librarian ID. However, Shwartz does not disclose or suggest either the library or the librarian having an ID or a library identifier, as recited in claim 13.

MacPhail teaches a document management system. The Office Action cites a portion of MacPhail that teaches each document having descriptors associated therewith, such as title, author, file, date filed, etc, which allows documents in the system to be searched, and the system allowing a security level to be associated with a document, and allowing authorization of certain users. MacPhail does not disclose or suggest attaching a unique packet identifier that matches a library identifier associated with the purchaser's library to a packet of text data, as recited in claim 13.

The cited section of MacPhail teaches a server library assigning each document a library-assigned document name (LADN). However, this name is assigned after the

document is received at the library, rather than before receiving a document at the library, as claimed in claim 13.

Additionally, the Office Action indicates that each packet in MacPhail must have a unique identifier and that since the server library performs services such as storing and retrieving documents electronically, the packet identifier must match the library identifier. However, in claim 13, a unique packet identifier is attached to a packet of text data that matches a library identifier associated with a purchaser's library before the packet is received at the library.

The Office Action indicates that MacPhail determines if the packet has a unique packet identifier and if so, determines whether the packet identifier matches a library identifier of a library, and if so, stores the packet to a data file in a library storage, again asserting that this must occur because the server library in MacPhail stores and retrieves documents. MacPhail does not disclose or suggest the claimed determinations as recited in claim 13, and storing and retrieving documents does not require a library to determine if an identifier of text matches a library identifier and only storing text with matching identifiers.

For at least the above noted reasons, the Applicant submits that claim 13 is allowable over the cited art. As claim 13 is allowable, the Applicant submits that claims 15-20, which depend from allowable claim 13, are therefore also allowable for at least the above noted reasons and for the additional subject matter recited therein.

III. Claims 21-25

Applicant's invention as set forth in claim 21 is directed to a method for processing data text for electronic books in a home system comprising a library and a

viewer, the method including sending a packet of data text, inserted in a video signal, from a remote operations center to the library.

Choudhury teaches a computer system and network. However, Choudhury does not disclose or suggest sending a packet of data text, inserted in a video signal. The Office Action cites element 3 in figure 1 and column 1, lines 37 as teaching this feature. However, the Applicant submits that these sections of Choudhury merely indicate the electronic transmittal of text, not the transmission of data text inserted in a video signal, as claimed in claim 21.

For at least this reason, the Applicant submits that claim 21 is allowable over the cited art. As claim 21 is allowable, the Applicant submits that claims 22-25, which depend from allowable claim 21, are also allowable at least for the above noted reason and for the additional subject matter recited therein.

The Applicant submits that Boulton, and Feigenbaum fail to cure the deficiency in Choudhury, Hartrick, Shwarts, and Ohara.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or

that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

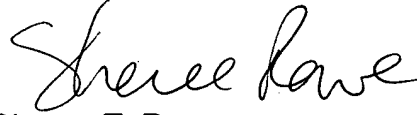
Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 026880-00017.

Application No.09/722,519
Attorney Docket No. 026880-00017

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read "Sheree Rowe". The signature is fluid and cursive, with the first name "Sheree" written in a larger, more prominent script than the last name "Rowe".

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